

Appl. No. 10/688,118
Atty. Docket No. 9066M2
Amdt. dated January 17, 2006
Reply to Office Action of Sept 27, 2005
Customer No. 27752

REMARKS

The Specification has been amended to correct typographical errors and to define the term "HLB". No new matter has been added. Claims 1 and 6 are amended, the basis of which is in the original claims and in the Specification, pages 6 and 15-16. Claims 1-20 remain pending in the instant Application and are presented for the Examiner's review in light of the above Amendments and the following comments.

Rejections Under 35 USC 102(b)

Claims 1 and 3 are rejected under 35 USC 102(b) over US 5,529,975 (herein "Chamberlain").

Rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed in the prior art. *In re Arkley*, 59 CCPA 804, 807, F.2d 586, 587, 172, USPQ 524, 526, (1972). Chamberlain does not disclose all of the material elements of present claims 1 and 3. Claims 1 and 3 of the present invention relate to the addition of the water-in-oil emulsion (containing the high molecular weight polymer) into an oil in water emulsion wherein the oil in water emulsion contains a softening active agent. The Chamberlain reference does not contemplate the addition of softening active agents into its compositions. Therefore, Chamberlain does not anticipate claims 1 and 3 of the present invention.

Furthermore, Claims 6-9 and 14 are rejected under 35 USC 102(a) over WO 02/48458 (herein "Barnholtz").

Rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed in the prior art. *In re Arkley*, 59 CCPA 804, 807, F.2d 586, 587, 172, USPQ 524, 526 (1972). Barnholtz does not disclose all of the material elements of present claims 6-9 and 14. Regarding claims 6-9, Barnholtz does not contemplate the addition of a water-in-oil emulsion (having the high molecular weight polymer in a discontinuous phase) into an aqueous dispersion of a quaternary ammonium softening active in order to modify the rheology of the aqueous phase. This teaching is lacking in Barnholtz.

Similarly, regarding claim 14, Barnholtz does not contemplate the addition of a water-in-oil emulsion (having the high molecular weight polymer) into the aqueous phase of the dispersed of a quaternary ammonium softening active in order to modify the rheology of the aqueous composition. Again, this teaching is lacking in Barnholtz.

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Therefore, Barnholtz does not teach every element of claims 6-9 and 14, and Applicants respectfully request removal of the 102 rejections.

Rejection Under 35 USC 103

Claims 4, 5, 10-13 and 15-20 are further rejected under 35 USC 35 USC 103 over Barnholtz in view of US 3,624,019 (herein "Anderson").

The combination of Barnholtz and Anderson does not establish a *prima facie* case of obviousness. The legal conclusion of obviousness requires that there be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new composition or method. In determining obviousness, "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and the obviousness of making the combination." *Lindeman Maschinenfabrick GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984); *Maize*, 5 USPQ 1788, 1793 (Fed. Cir. 1988). The fact that the references relate to the same area of technology is insufficient. *In re Geiger*, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

In columns 4-5, Anderson only teaches the inversion of the water-in-oil emulsion into *water* having no other components, except for a surfactant. Anderson does not teach the inversion of water-in-oil emulsions into a vehicle also containing a softening active ingredient, as well as an electrolyte. Furthermore Barnholtz teaches that electrolytes serve as rheology modifying agents and will decrease the viscosity of the Barnholtz compositions. Therefore, Anderson contains no suggestion or motivation to combine the water-in-oil emulsion into a system comprising other rheology modifying agents such as electrolytes, as in Barnholtz.

Furthermore, the combined teachings of the cited references at most make it obvious to try combining inversion of water-in-oil emulsions with the Barnholtz composition. Mere obviousness to try is not a proper ground for rejection.

[T]here is usually an element of 'obviousness to try' in any research endeavor; [. . .] it is not undertaken with complete blindness but rather with some semblance of a chance of success, and [. . .] patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system[.]

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In re Tomlinson, Hall, and Geigle, 150 U.S.P.Q. 623, 626 [2] (CCPA 1966). (*See also, Ex parte Argabright*, 151 U.S.P.Q. 703 (Bd. of Appls. 1967); In re Goodwin, 198 U.S.P.Q. 1 (CCPA 1978).

Even if these references taken together provided impetus to try the combination, the results are unpredictable. Certain requirements must be met in order for the softening actives to show efficacy while remaining stable in the composition. The effectiveness/stability would be unpredictable since Barnholtz teaches that the electrotype will alter the viscosity of the composition. It would therefore be unpredictable how the overall rheology would be effected by the combination since an electrolyte present in the water in Barnholtz.

Therefore, even if the combination of [Barnholtz and Anderson may have been arguably "obvious to try", this does not render the subject invention obvious within the meaning of 35 USC §103.

Claims 5, 10-13, and 16-20, each depend from claim 4 or 15, and are therefore non-obvious over Barnholtz in view of Anderson as well. If an independent claim is nonobvious under 35 USC 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Therefore, none of the cited prior art references suggest or motivate one of skill in the art to modify the teachings of the reference to obtain the claimed invention.

Conclusion

In view of the above amendments, facts and arguments, the Examiner is respectfully requested to reconsider and withdraw or modify all of the rejections. In view of the above, Applicants respectfully request reconsideration of the application and allowance of all of the claims.

Respectfully submitted,
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